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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,692	05/05/2006	Stephen D. Horton	1200325N US	4925
35227 7590 03/18/2008 POLYONE CORPORATION 33587 WALKER ROAD AVON LAKE, OH 44012				
EXAMINER NGUYEN, KHANH TUAN				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/595,692

**Applicant(s)**

HORTON, STEPHEN D.

**Examiner**

KHANH T. NGUYEN

**Art Unit**

1796

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 27 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-5,7-10,12-14 and 16-20.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796

Continuation of 5. Applicant's reply has overcome the following rejection(s): The objection to the specification for containing embedded hyperlink and/or other form of browser-executable code as recited in the MPEP 608.01(a) is withdrawn in view of Applicant's amendment.

Continuation of 11. does NOT place the application in condition for allowance because:

The rejection of claims 1-5, 7-10, 12-14 and 16-20 under 35 U.S.C. 103(a) as being unpatentable over either Geer et al. (U.S. Pub. 2002/0195592 A1) or Viswanathan et al. (U.S. Pat. 6,972,098 B1) in view of Lubnir et al. (U.S. Pub. 2003/0195293) is maintained for the reasons set forth in the FINAL Office Action filed on 02/04/2008.

Applicant's arguments filed on 02/27/2008 have been fully considered but they are not persuasive. In response to Applicant's remark, on pages 7-10, Applicant argues the combination of references employs "unfortunate and impermissible hindsight." The Examiner respectfully disagrees with the Applicant argument.

In response to applicant's argument concerning impermissible hindsight, examiner asserts that "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper." In re McLaughlin, 170 USPQ 209, 212 (CCPA 1971). In the instant case, Geer et al. (para. [0011] and [0018]) clearly teaches a coating composition comprising an inherently conductive polymer and a waterborne polyurethane resin. Similarly, Viswanathan et al. (Col. 6, lines 41-59; Col. 7, lines 14-15; Col. 7, lines 25-28) teaches a coating system comprising an inherently conductive polymer such as lignosulfonic acid doped polyaniline and waterborne polyurethane. The differences between Geer et al. and Viswanathan et al. references with the instant application is that both Geer et al. and Viswanathan et al. failed to suggest or disclose a nonionic waterborne polyurethane. However, in an analogous art of coating and film forming composition [0008], Lubnir et al. teaches (Abstract) a nonionic waterborne polyurethane having the same structure as the claimed nonionic waterborne polyurethane as recited in claim 4. Thus, one having an ordinary skill in the art at the time the invention was made would have found it obvious to arrive at the claimed coatable mixture by substituting the waterborne polyurethane of Geer et al. or Viswanathan et al. with a nonionic polyurethane of Lubnir et al. to improve moisture resistance and spreadability of the said mixture. The simple substitution of one known waterborne polyurethane of Geer et al. or Viswanathan et al. for a nonionic waterborne polyurethane of Lubnir et al. would have yielded a predictable result because the references in combination teach all the claimed components for similar utility. The Examiner further notes that the USPTO is not equipped to perform laboratory testings and experimental benchworks to measure the properties of the resulting composition. The burden is on the applicant to prove otherwise.

Applicant further argues that Table 2 of the specification demonstrates unexpected results by comparing compositions (Examples 1-5) having nonionic waterborne polyurethane with composition (A) having ionic waterborne polyurethane.

In response to Applicant's argument concerning unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have recognized the advantages of nonionic waterborne polyurethane over ionic, cationic or amphoteric waterborne polyurethane through routine experimentation for best results. It is within the expected skill of a skilled artisan to be able to determine the optimal waterborne polyurethane to be incorporated into a coating formulation by experimenting with different types (nonionic, ionic, cationic and amphoteric) of waterborne polyurethane with an inherently conductive polymer to determine the most stable formula. Moreover, the argument of Table 2 in the specification showing superiority of nonionic waterborne polyurethane over ionic waterborne polyurethane is at a specific concentration (66-89 wt. %) with polyaniline which is not commensurate in scope of the claims. The instant independent claims are much broader in scope. Applicant is invited to incorporate the said concentration with the specific combination of nonionic waterborne polyurethane and lignosulfonic acid-grafted polyaniline into the independent claims.

Based on the above rationale, it is believed that the claimed limitations are met by the references submitted and therefore, the rejection is maintained.